

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte TAKAAKI TATSUMI

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Appeal No. 1999-1788  
Application No. 08/533,939

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ON BRIEF<sup>1</sup>

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Before HAIRSTON, DIXON, and GROSS, Administrative Patent Judges.

GROSS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 5, 6, 10, 14, and 18. Claims 2 through 4, 7 through 9, 11 through 13, and 15 through 17 are objected to. In the Examiner's Answer, page 2, the examiner withdraws

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<sup>1</sup> We observe that on June 5, 2001 (paper no. 17), appellant filed a waiver of the oral hearing set for June 12, 2001.

Appeal No. 1999-1788  
Application No. 08/533,939

the rejection of claims 5 and 18, indicating that they are now objected to as being dependent from a rejected base claim.

Therefore, claims 1, 6, 10, and 14 remain before us on appeal.

Appellant's invention relates to a method and apparatus for simulating the electrical characteristics of a semiconductor device. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A method for simulating the electrical characteristic of an electronic device comprising the steps of:

specifying the material of a part of interest of the electronic device;

specifying the electrical characteristics of the part of interest of the electronic device; and

specifying the shape of the part of interest of the electronic device, said specification of the shape being performed by selecting it from among several preselected simplified shape models.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Gough et al., "An Integrated Device Design Environment for Semiconductors," 10 IEEE Transactions on Computer-Aided Design of Integrated Circuits and Systems no. 6, 808-21 (June 1991) (Gough)

Claims 1, 6, 10, and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gough.

Appeal No. 1999-1788  
Application No. 08/533,939

Reference is made to the Examiner's Answer (Paper No. 12, mailed September 29, 1998) for the examiner's complete reasoning in support of the rejection, and to appellant's Brief (Paper No. 9, filed May 6, 1998) and Reply Brief (Paper No. 14, filed November 30, 1998) for appellant's arguments thereagainst.

OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellant and the examiner. As a consequence of our review, we will reverse the obviousness rejection of claims 1, 6, 10, and 14.

The examiner states (Answer, page 4) that Gough does not "specifically detail several preselected simplified shape models exactly as claimed. However, it would have been obvious . . . to specify any shape since Gough et al. taught a polygon which encompasses many kind [sic, kinds] of shapes including the claimed preselected simplified shapes." Further, in the response to appellant's argument, the examiner asserts (Answer, page 4) that:

"[S]electing a shape among plural shapes" could be any shape one could think of or a shape available in a designer's tool or . . . as in Gough's system if the device editor allowed the user to specify a geometry/ shape of a device then it is clearly obvious . . . to select a shape from any source."

Appellant argues (Brief, pages 10 and 11) that Gough discloses that the user may define shapes, but not that the user may select a shape from among preselected simplified

shape models. We agree with appellant that defining shapes involves inputting the various parameters, whereas selecting a shape from a list of models does not require such steps. Said another way, for the claimed step of selecting, the shapes are predefined, which differs from the user having to define the shapes.

We note that Gough discloses (page 812, second full paragraph) that after a design is complete it can be saved and used by others, wherein the other users may load and modify the structure to their own requirements. Thus, Gough suggests giving the user the ability to select a predefined shape. However, the stored shapes are not simplified shape models, but, rather, are complex structures that have been defined by someone else. Thus, Gough fails to disclose or suggest a step of selecting a shape "from among several preselected simplified shape models," as recited in claims 1 and 14. Further, Gough fails to disclose any means for specifying the shape "by selecting it from among several preselected simplified shape models," as recited in claims 6 and 10. See *In re Donaldson Co.*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1849

Appeal No. 1999-1788  
Application No. 08/533,939

(Fed. Cir. 1994). Accordingly, as the examiner has failed to meet each and every element of the claims, the examiner has failed to establish a *prima facie* case of obviousness.

Consequently, we cannot sustain the obviousness rejection of claims 1, 6, 10, and 14.

Appeal No. 1999-1788  
Application No. 08/533,939

CONCLUSION

The decision of the examiner rejecting claims 1, 6, 10,  
and 14 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JOSEPH L. DIXON	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
ANITA PELLMAN GROSS	)	
Administrative Patent Judge	)	

APG:clm

Appeal No. 1999-1788  
Application No. 08/533,939

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